



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,007	11/20/2003	Alan Michael Jaffee	7237	8750
29602	7590	04/04/2008		
JOHNS MANVILLE 10100 WEST UTE AVENUE PO BOX 625005 LITTLETON, CO 80162-5005			EXAMINER MATZEK, MATTHEW D	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 04/04/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/718,007	Applicant(s) JAFEE ET AL.
Examiner MATTHEW D. MATZEK	Art Unit 1794

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 March 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): the 112th rejection of claims 82-84.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 51-64, 71-84, 91-94 and 99
Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Matthew D Matzek/
Examiner, Art Unit 1794

/Norca L. Torres-Velazquez/
Primary Examiner, Art Unit 1794

Continuation of 11, does NOT place the application in condition for allowance because: Applicant argues that the Jaffee 1:132 Dec. clearly states that embodiments of '846 are unsuitable because of insufficient stiffness and toxicity of the smoke. As stated in final rejection dated 2/1/2008 the Taber stiffness of 45 set forth in '846 is about 50 and Applicant has failed to demonstrate how toxicity is related to the claimed flammability test. Applicant argues that claims 91 and 99 are more definite than claim 51 due to the incorporation of the pre-grant publication information into the body of the claim and as such are in fact definite. Where possible, claims are to be complete in themselves. Incorporation by reference to a specific reference "is permitted only in exceptional circumstances where there is no practical way to define the invention in words and where it is more concise to incorporate by reference than duplicating a drawing or table into the claim. Incorporation by reference is a necessity doctrine, not for applicant's convenience." Ex parte Fressola, 27 USPQ2d 1608, 1609 (Bd. Pat. App. & Inter. 1993) (citations omitted). See MPEP § 608.01(m). Applicant argues that the incorporated by reference material is not essential, but does add to the definiteness of the claim. Examiner disagrees with this assertion as the incorporated material is essential because Applicant is relying upon it to distinguish the claimed invention from that of the prior art. Applicant argues that Examiner has relied upon improper hindsight to arrive at the claimed invention. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Applicant argues that mats of '846 fail to teach the claimed thicknesses or Taber values. These issues have been addressed in the aforementioned Final rejection and would have been obvious in view of '846. Applicant argues that folding of the mat in Example 3 and pleating of the mat in Example 4 of '846 is quite different than the scoring and folding that the claimed mat must endure. Examiner has addressed the physical limitations and intended uses that are instantly claimed. Applicant is again encouraged to provide evidence to substantiate the claim that the mat of '846 is incapable of being used in the instantly claimed manner. Applicant argues that nothing in '846 suggests the combination of prior art set forth by Examiner to reject the instant claims. Examiner has relied upon the secondary and tertiary references to provide the motivation for the combination of references. Applicant argues that there is no reason to substitute the binder of '846 with that of Arkens. The motivation to swap the binders comes from the Arkens reference, in particular, the abstract and the first column. Arkens teaches the use of acrylic resins as binders. Applicant argues that Chenoweth is directed to a very different type of mat with a different type of glass fibers than that which is currently claimed. Chenoweth, '846 and the instantly claimed article are all directed to fiberglass mats comprising polymeric fibers and binder. Chenoweth provides for the claimed fiber levels. Applicant repeats the arguments set forth in the two 1:132 Decs. Examiner has previously addressed the declarations and their arguments for the novelty of the instant invention. Applicant argues that '846 does not provide for the claimed Taber Stiffness. Examiner has and continues to take the position that Example 2 provides for a stiffness of 45, which Examiner interprets to be about 50. Furthermore, Jaffee teaches that the board of Example 2 is stiffer than liked, but does not say that it cannot perform in the desired function. It has been shown that all disclosures in a reference must be evaluated for what they fairly teach one of ordinary skill in the art. Thus, in In re Smith, 32 CCPA 959, 148 F.2d 351, 65 USPQ 167; in In re Nehrenberg, 47 CCPA 1159, 280 F.2d 161, 126 USPQ 383; and in In re Watanabe, 50 CCPA 1175, 315 F.2d 924, 137 USPQ 350, show that rejections have been affirmed based upon art which rendered the claimed invention obvious to those of ordinary skill in the art despite the fact that the art teachings relied upon were phrased in terms of non-preferred embodiments or as being unsatisfactory for the intended purpose, see In re Hans Theodor Boe, 53 CCPA 1079, 355 F.2d 961; 148 USPQ 507. Applicant argues that Examiner is improperly considering the limitation "consisting essentially of". Examiner has considered Applicant's arguments, but maintains his interpretation of the aforementioned limitation. The use of the term "consisting" would provide closed-ended coverage Applicant apparently desires. Applicant argues that claimed properties are not inherent to '846. Examiner is not saying that all the properties are inherent to '846. Examiner has taken the position that the Taber Stiffness is provided for in '846 (i.e. 45 reads on at least about 50) and with regards to the evidence to support an allegation of inherency, Examiner has relied upon the use of like materials to support a presumption of inherency. Applicant argues that Applicant argues that failing to give weight to properties recited in article claims is a reversible error, particularly when evidence to the contrary has been presented, it is improper to ignore property limitations in the claims when the composition of the item having the properties is different than reasonably taught by the reference and especially when the Applicant is claiming the properties are critical to a particular different application and/or are unexpected. First, Applicant has failed to demonstrate the claimed properties are unexpected. Second, the claimed Taber stiffness is provided for Jaffee and fire resistance is also a property of Jaffee. The claimed ability for use in a compressible ceiling tile is necessarily present because all of the structural and compositional are provided for and in combination would perform in the claimed manner.